

## REMARKS

Claims 1 through 20 were examined and stand rejected under 35 USC 112, and under 35 USC 102 (e) or under 35 USC 103 (a). In addition, the claims 12 through 20 were objected to and the Abstract required correction. The drawings were objected to as obviously informal. The specific rejections set forth in the June 29, 2004 Office Action are as follows, and as set forth in the specific section headings below:

Claims 12 through 20 were rejected under 35 USC 112 on the basis that the examiner did not understand the phraseology to be clear as to the expressions “tapered outwardly toward said bottom” and “tapered inwardly toward said bottom”. Applicant is sympathetic toward the Examiner’s concern for clarity but respectfully disagrees as to the need or appropriateness for a 35 USC 112 rejection. The phraseology in the claims are the same as in the drawing descriptions in the specification, and taken in that context, the meanings are clear, namely, that tapered inwardly or outwardly from the bottom means inwardly toward a center or outwardly means away from a center, and toward the bottom means as one’s eyes move in a direction toward the bottom. Notwithstanding the applicant’s position, a clarifying amendment has been made to obviate the rejection and to clarify the claim limitations. Specifically, the phrases “ to created an inverted V-notch” and “to create an uprighted V-shape”, have been added.

Applicant further responds as follows:

**I. Claims 1 through 5, 10, and 11 rejected under 35 USC 102 (e)**

**based on the Chen patent (6,676,001)**

The Chen patent issued on January 13, 2004 and was filed on March 20, 2003. It is believed to be obviated in view of the attached Declarations that swear behind it. For this reason, the rejections based on this reference should be withdrawn.

Separately from the Declarations, the Chen reference is no longer applicable because the new claims now specifically recite "consisting of". The Chen device is for a screw gun and not a nail gun. As such, Chen's device requires the additional complex aspects not needed and useless in the present invention device. For example, the Chen device is threaded; the present invention device is not. The Chen device requires a collar; the present invention device does not. The Chen device has biasing springs; the present invention does not. The Chen device has two screw positioning members protruding inwardly; the present invention device does not. The Chen device requires at least four or five parts; the present invention does not and is made of a single part. The Chen device requires complex machining or cam action molding to be fabricated; the present invention does not. It can be molded without complex cam action as it has no inside fittings. The Examiner has inadvertently assumed or identified the Chen Figure 3 device as a nail gun; however, as stated in the specification of

Chen at line1, column 3, the device is a “screw driving gun”. For all of these reasons it is believed that the rejections based on Chen should be withdrawn.

**II. Claims 6 through 9 rejected under 35 USC 103 (a) based on the  
Chen patent (6,676,001) in view of Roy (2,169,433)**

This rejection is based on the Chen reference as the primary reference. Therefore, all of the different arguments made above and the attached Declarations are repeated and are incorporated into this section by reference. The Examiner has combined the Chen reference with the Roy reference. Applicant respectfully disagrees with this combination for a number of reasons. First, the Chen teaching relates to screw driving guns and not nail guns as does Roy. Second, there is no motivation to combine these references except with respect to a way of trying to show the present invention teachings. In other words except for the hindsight approach after seeing the present invention, there is no motivation to combine these references because they are directed to different purposes for different types of fasteners using different mechanisms. Third, Roy does not overcome the shortcomings of the Chen reference stated above. Fourth, if the Roy teachings were to be combined with the Chen teachings, the results would not only be different from the present invention as set forth in the new claims herein, but the combination would, in fact, be inoperable. The profile cut of Roy, if made in the Chen device, would eliminate the screw holding members’

sockets or part of them, so that they couldn't work. For all of these reasons, the rejections based on Chen in view of Roy should be withdrawn.

**III. Claims 12 through 15, 19 and 20 rejected under 35 USC 103 (a) based on the Chen patent (6,676,001) in view of Thornton (2,660,727)**

This rejection is based on the Chen reference as the primary reference and Thornton as the secondary reference. Therefore, all of the different arguments made above and the attached Declarations are repeated and are incorporated into this section by reference.

Applicant respectfully disagrees with the combination of Chen and Thornton for a number of reasons. First, the Chen teaching relates to screw driving guns and not nail guns as does Thornton. Second, there is no motivation to combine these references except as suggested above with the Roy reference, namely, with respect to a way of trying to show the present invention teachings. In other words except for the hindsight approach after seeing the present invention, there is no motivation to combine these references because they are directed to different purposes for different types of fasteners using different mechanisms. Third, Thornton does not overcome the shortcomings of the Chen reference stated above. Fourth, if the Thornton teachings were to be combined with the Chen teachings, the results would not only be different from the present invention as set forth in the new claims herein, but the combination would, in fact, be inoperable. The profile cut of Thornton, just as with Roy, if made in the

Chen device, would eliminate the screw holding members' sockets or part of them, so that they couldn't work. For all of these reasons, the rejections based on Chen in view of Roy should be withdrawn.

**IV. Claims 16 through 18 rejected under 35 USC 103 (a) based on the Chen patent (6,676,001) in view of Roy (2,169,433) and apparently also in view of Thornton (not stated in the beginning of Paragraph 8 of the Office Action)**

This rejection is based on the Chen reference as the primary reference. Therefore, all of the different arguments made above and the attached Declarations are repeated and are incorporated into this section by reference. The Examiner has combined the Chen reference with the Roy reference and presumably the Thornton reference. Applicant respectfully disagrees with this combination for a number of reasons. First, the Chen teaching relates to screw driving guns and not nail guns as do Thornton and Roy. Second, there is no motivation to combine these references except with respect to a way of trying to show the present invention teachings. In other words except for the hindsight approach after seeing the present invention, there is no motivation to combine these references because they are directed to different purposes for different types of fasteners using different mechanisms. Third, neither Roy nor Thornton, nor both in combination, overcome the shortcomings of the Chen reference stated above. Fourth, if the Roy teachings and the Thornton teachings were to be combined with the Chen teachings, the results would not only be different from

the present invention as set forth in the new claims herein, but the combination would, in fact, be inoperable. The profile cuts of both Roy and Thornton, if made in the Chen device, would eliminate the screw holding members' sockets or part of them, so that they couldn't work. Fifth, it is not physically possible to combine the teachings of Roy and Thornton because they offer different shapes, cut outs and profiles that are mutually exclusive, serve competing and diverse purposes and if actually combined, would defeat their respective purposes as both cut outs simultaneously made to a single product would fail for having each of the shapes cutting into each other and thus not functioning as intended. For all of these reasons, the rejections based on Chen in view of Roy and Thornton should be withdrawn.

## V. Conclusion

In view of all of the above comments and the enclosed Declarations, it is urged that new claims 21 through 40 should be allowed. A Petition and Fee for the late filing is also enclosed. A Notice of Allowance is earnestly solicited.

Thank you.

Respectfully submitted,

Dated: 14 November 2004



Kenneth P. Glynn  
Reg. No. 26,893  
Attorney for Applicant  
24 Mine Street  
Flemington, NJ 08822  
(908) 788-0077 Tele  
(908) 788-3999 Fax

KPG:hub  
EM RRR No. ED 398388355 US  
Cc: Brian Betz